

REMARKS/ARGUMENTS

Reconsideration of the application is requested.

Claims 1-5 and 7-11 remain in the application. Claims 1 and 7 have been amended.

In item 7 on page 2 of the above-identified Office action, claims 1, 7 have been rejected as being unpatentable over Lubart (U.S. 2005/0192913 A1) in view of Schoeffler (U.S. 2001/0049745 A1) under 35 U.S.C. § 103(a).

In item 10 on page 6 of the above-identified Office action, claims 2-3, 8-9 have been rejected as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen (U.S. Patent No. 6,405,243 B1) under 35 U.S.C. § 103(a).

In item 15 on page 9 of the above-identified Office action, claims 4, 10, have been rejected as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen, even further in view of Kuebert et al. (U.S. Publication No. 2002/0165729 A1) (hereinafter "Kuebert") under 35 U.S.C. § 103(a).

In item 18 on page 10 of the above-identified Office action, claims 5, 11, have been rejected as being unpatentable over Lubart in view of Schoeffler, further in view of Nielsen, further in view of Kuebert, even further in view of Webb (U.S. 2004/0020978 A1) under 35 U.S.C. § 103(a).

The rejections have been noted and the claims have been amended in an effort to even more clearly define the invention of the instant application. Support for the changes is found on page 2, lines 8-21 and page 4, lines 5-15 of the specification and in the original claims of the instant application.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a method of forwarding post, having the steps of:

scanning an address face of the post for a TAG ID specific to the post;
consulting a database for records related to the TAG ID, wherein the records contain information indicating if said TAG ID specific to the post is expired and if a redirection fee has been paid,
if the TAG ID specific to the post is expired, automatically determining if an addressee of the post maintains a forwarding service account, and
if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee destination address in the forwarding service account.

While Lubart discloses a method for forwarding post, Lubart does not disclose the claimed features of scanning an address face of the post for a TAG ID specific to the post, and consulting a database for records that contain expiration information about a specific post TAG ID.

Lubart discloses scanning an address face of the post for character recognition, for a pseudo name displayed on the mail, for a barcode or the like (paragraph [0048]).

For forwarding purposes Lubart uses a pseudo name displayed on the mail object.

Lubart does not use a TAG ID specific to the post. Lubart discloses consulting a database for records related to a pseudo name. However, a pseudo name is not a TAG ID. Therefore, consulting a database for records containing information related to the TAG ID specific to the post is not disclosed.

In paragraph 24 of the Final Office Action, the Examiner states that a machine readable pseudo name is a TAG ID or is equivalent to a TAG ID. The Examiner states that a pseudo name is a code that distinguishes the letter on which it is printed over all other letters. Applicant respectfully disagrees with the Examiner's statement. A machine readable pseudo name is not a TAG ID. An ID is an identification code which distinguishes the letter on which it is printed from all other letters in a sorting machine or in a distribution centre. A pseudo name does not have this property or capability. A pseudo name is not a TAG ID for a specific post as recited in the instant claims.

Lubart defines a pseudo name in paragraph [0039]. A pseudo name is a unique identifier that identifies a user. This means that two letters sent by the same user may carry the same pseudo name. Not only private persons send more than one letter a day. Moreover, companies send hundreds of letters, the letters being delivered together to the sorting destination and being sorted together. A sorting

process may be busy with letters from only one sender for a reasonable time. All these letters may carry the same pseudo name.

For this reason, a pseudo name is not suitable for distinguishing one letter from all other letters. A pseudo name is therefore neither identical nor equivalent nor similar to a TAG ID specific to a post as recited in the present claims.

Lubart does not disclose scanning an address face of the post for a TAG ID specific to a post, since the scanning apparatus will not be able to look for and identify any TAG ID specific to the post, nor does Lubart disclose consulting a database for records related to the TAG ID in which the records have information about a TAG ID specific to the post, since there is no TAG ID on letters as disclosed by Lubart. Consequently, there is no related data base to look at records related to the TAG ID specific to the post.

Nor does Lubart disclose the claimed feature that the data base records contain information indicating if the TAG ID specific to the post is expired.

Lubart discloses a profile related to the pseudo name (see paragraphs [0040] and [0049]). This profile data has information for a follow me or follow up address that is valid only during a particular date range (see paragraphs [0022] and [0053]). The follow up address may expire at the end of the date range. However, the pseudo name per se does not expire. Nothing written on the letter and read by any reading device in Lubart expires.

The Examiner states in paragraph 25 that since a pseudo name is used to retrieve a profile, it is as if the pseudo name expires. Applicant disagrees with the Examiner's conclusion. The present claimed invention is actually opposite from Lubart's disclosure. In Lubart, the information printed on the letter is chosen in such a way that it *does not* expire. Lubart's invention makes it possible for a sender to choose a pseudo name which – for good reason – does not expire. If it expires, the sender would have to pick a new pseudo name with every expired profile. This is not Lubart's intention. Lubart generates two information levels. The first information level is the pseudo name. It is printed on the letter and is usable any time the sender desires. A second level is the profile. The profile is not printed on the letter since it is intended to be changed easily. It only is database information. Therefore, in Lubart only enduring information is printed on the letter and expiring information is kept off the letter.

Therefore, Lubart does not disclose the feature that records contain information indicate if a pseudo name is expired, or records containing information indicating if a TAG ID specific to the post has expired as recited in the claims.

Lubart does not disclose the claimed limitation of consulting a database for records that have information indicating if a redirection fee has been paid.

The limitation "if a redirection fee has been paid" is expressly recited in claims 1 and 7, contrary to the Examiner's assertion that it is not set forth in the claims.

Lubart discloses a check of postage due (paragraph [0059]), a check for a missing stamp (paragraph [0071]), and in paragraphs [0077] and [0078] an access to a franking profile, and charging a small additional fee for use of the follow me/follow up service. The Examiner cited Lubart, paragraph [0078], stating that this is disclosure for the feature “consulting a database for records related to the TAG ID, the records indicating if a redirection fee has been paid”.

However, Lubart’s disclosed method distinguishes considerably from the method as claimed. Lubart charges for an additional fee upon redirection. The method according to claim 1 does not charge any fee, but checks whether the fee *has been* paid. This different method has the advantage that a shortfall in payment is avoided in any case, since any action will only take place if the fee has already been paid. In contrast to this, Lubart charges a fee but has no guarantee that a payment will follow afterwards. Charging means that the payment will take place at the moment of charging (but only in case the account is covered), or afterwards. In contrast to this, the present claimed invention is based on a prior or beforehand payment.

Therefore, the claimed feature of checking a database as to whether a redirection fee has been paid distinguishes significantly from the charging step in Lubart.

Nor does Lubart disclose the claimed feature if the TAG ID specific to a post is expired, automatically determining if an addressee of the post maintains a forwarding service account, the account being debited.

The Examiner is of the opinion that this feature is disclosed in Schoeffler, paragraphs [0028], [0047] and [0088].

However, Schoeffler fails to disclose a TAG ID specific to a post, any action upon an expiration of an ID, any automatic determination process, and a forwarding service account maintained by the addressee, the account being debited.

Regarding the claim limitation of maintaining a forwarding service account, the Examiner states that Schoeffler, paragraph [0028], discloses a forwarding service account by the addressee. In Schoeffler, paragraph [0028], a data base entry of the addressee is disclosed. This data base entry contains a new address and at least one old address. However, the data base entry is not a forwarding service account having the capability of being automatically debited as recited in the instant claims.

The features missing in Lubart are not disclosed in Schoeffler. Thus, one skilled in the art would not be able to arrive at the present claimed invention by combining Lubart with Schoeffler.

Schoeffler does not disclose the claimed features of scanning an address face of the post for a TAG ID specific to the post, and consulting a database for records related to the specific post TAG ID, records indicating the specific post TAG ID is expired, consulting a database for records related to the specific post TAG ID, the records indicating if a redirection fee has been paid, and if the specific post TAG ID

is expired, and automatically determining if an addressee of the post maintains a forwarding service account, the account being debited.

It is apparent that Lubart is missing several features recited in claims 1 and 7. Accordingly, claims 1 and 7 are believed to be patentable distinct over Lubart with respect to these previously discussed features.

The secondary Schoeffler reference does not make up for or overcome the deficiencies in Lubart. The features missing in Lubart are not disclosed in Schoeffler as discussed above.

The Examiner proposes to make up for the many deficiencies of the primary Lubart reference by extracting isolated individual features from the several secondary references of Schoeffler (discussed above) and Nielson, Kuebert, and Webb, discussed below.

Nielsen discloses a networking system for forwarding an email message to an updated email address. After changing his or her email address the user sends the new email information to an address change server. The server stores the new information in its database. The server forwards a sender's email message to the new recipient's new email address upon being contacted by the sender.

Kuebert discloses a mail delivery system wherein the delivery point and delivery time for a mail item can be changed while in route. This is accomplished by determining

that the mail is in transit and then sending a notification to change the delivery destination or time of delivery. There is no disclosure or suggestion of establishing a mail redirection account, let alone automatically determining whether a mail forwarding account exists in the first instance, and if it does then automatically debiting the account for the redirection of mail as recited in the claims of the instant application.

Webb discloses a mailbox with a UV lamp that produces UV and ozone. The Examiner relies on Webb for the teaching of using a pre-selected time delay prior to destruction of post. The process of Webb destroys biological organisms. It does not destroy the post as recited in dependent claims 4,5, 10, and 11.

The Examiner has recognized the significant deficiencies of the prior art, in particular the Lubart and Schoeffler references, and that the prior art do not disclose the claimed features of the present invention. In an effort to overcome these deficiencies, the Examiner has been required to resort to extracting individual isolated bits and pieces of the claimed invention from several different references to arrive at a compilation that he believes, incorrectly so, meets the claimed features. It is respectfully submitted that such a compilation is an improper rejection based solely on hindsight reconstruction of applicant's claimed invention after the Examiner has read applicant's specification and claims, and is not suggested by the distinctly different problems addressed by the respective references. There is no logical basis for combining the references as proposed by the Examiner. It is respectfully submitted that the Examiner is overreaching in his proposed combination of

references in an attempt to show the claimed invention. The result of the Examiner's compilation is a mosaic of prior art features.

The claimed features of scanning the TAG ID specific to the post and verifying if it is expired by consulting a database having records that indicate if the TAG ID specific to the post is expired, automatically determining if an addressee of the post maintains a forwarding service account, and forwarding the post to an addressee destination address in the forwarding service account, are important aspects of the present invention. Claims 1 and 7 now more clearly recite that the TAG ID is specific to a post and is read and checked in a data base having specific post information as to whether the specific TAG ID has expired, and that if the TAG ID is expired there is an automatic determination if the addressee maintains a forwarding account. These features are not disclosed in the applied prior art references. Nor would the claimed invention be obvious from the combination of references a proposed by the Examiner.

The references do not show "scanning an address face of the post for a TAG ID specific to the post; consulting a database for records related to the TAG ID, wherein the records contain formation indicating if said TAG ID specific to the post is expired and if a redirection fee has been paid, if the TAG ID specific to the post is expired, automatically determining if an addressee of the post maintains a forwarding service account, and if the forwarding service account is maintained, debiting the account automatically in an appropriate amount and forwarding the post to an addressee

destination address in the forwarding service account” as recited in claim 1 of the instant application. Independent apparatus claim 7 contains similar limitations.

In view of the foregoing, reconsideration and allowance of claims 1-5 and 7-11 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

If an extension of time is required, petition for extension is herewith made. Any extension fee associated therewith should be charged to Deposit Account Number 12-1099 of Lerner Greenberg Sterner LLP.

Please charge any other fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Sterner LLP, No. 12-1099.

Respectfully submitted,

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